

ESTTA Tracking number: **ESTTA544751**

Filing date: **06/24/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056125
Party	Plaintiff U.S.A. Dawgs, Inc.
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Date	06/24/2013
Attachments	GDOGGS TM MSJ Reconsider 24 Jun 2013.pdf(239716 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

USA DAWGS, INC.,  
  
Petitioner,  
  
v.  
  
James Sanders,  
  
Registrant.

Cancellation No. 92056125

Registration No. 3842092

**PETITIONER'S REQUEST FOR RECONSIDERATION OF THE DECISION  
DENYING PETITIONER'S MOTION FOR SUMMARY JUDGEMENT**

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## **I. OVERVIEW**

On May 31, 2013, the Board issued a decision denying U.S.A. Dawgs, Inc.'s ("USA Dawgs" or "petitioner") Motion for Summary Judgment and suspended proceedings in this cancellation regarding Registration No. 3842092 (the alleged "GDOGGS" mark) pending final disposition of the civil action between petitioner and James Sanders ("respondent") and Jeffrey Olian (attorney for the respondent).

Petitioner submits this Request for Reconsideration and brief pursuant to 37 CFR § 2.127(b)

Respectfully, petitioner states that the Board erred in its decision because (i) respondent did not deny the salient allegations in the petition to cancel, (ii) respondent did not oppose any substantive arguments in the motion for summary judgment, and (iii) the unrelated issues and causes of action in the Nevada Litigation between Respondent and Petitioner are not dispositive of, and cannot have any bearing on this Board proceeding.

## **II. LEGAL STANDARD**

Generally, the relevant standard for reconsideration, modification or clarification under 37 CFR § 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. The parties may not introduce new evidence or use the opportunity to reargue the points presented in the original motion. (TBMP §518).

### **III. ARGUMENT**

#### **A. The Board erred in finding that the respondent denied the salient allegations in the petition to cancel.**

The Board's decision indicates that the respondent denied the salient points in the petition cancel, however, a review of the Petition (Dkt 1) and the Answer (Dkt. 7) reveals that this judgment is in error, and, respondent in fact, repeatedly admitted the salient points in the petition.

Registrant has admitted that as of the relevant time, no product existed that carried the alleged 'GDOGGS' mark in any form. Since the mark was not being used in commerce, the registration must be cancelled. The registration of a mark that does not meet the "use in commerce" requirement by being placed on the goods, or container for the goods, that are then sold or transported in commerce, is void ab initio. 15 U.S.C. § 1127; see also, *Louisiana Athletics Down on the Bayou, L.L.C. v. Bayou Bowl Ass'n*, CIV.A. 11-303-BAJ, 2013 WL 2102354 (M.D. La. May 14, 2013). Here, respondent admits that there were no goods bearing the alleged GDOGGS mark.

Paragraph 29 of the Petition to Cancel states that "Products bearing the GDOGGS logo, such as those depicted on Page 15 of the Specimen, did not exist, and were not used in commerce, on September 1, 2009 as claimed in the statement of use and do not exist today." (Petition to Cancel, Dkt. No. 1, at ¶ 29) In response, respondent admitted the allegation by stating "Respondent admits the allegations set forth in Paragraph 29 of the Petition for Cancellation" (Respondent's Answer to Petition for Cancellation, Dkt. No. 7, at ¶ 29)

Paragraph 31 of the Petition to Cancel states that "On information and belief none of

products on any of the other pages of the published Specimen have ever been produced, and were not, at the time of the trademark application, being used in commerce.” (Dkt. No. 1, at ¶ 31) In response, respondent admitted the allegation by stating, “Respondent admits the allegations set forth in Paragraph 31 of the Petition for Cancellation.” (Dkt. No. 7, at ¶ 31)

Paragraph 32 of the Petition to Cancel states: “Like the fraudulent mock-ups depicting Petitioner’s footwear, these other artist renditions purposefully obscure the original brand in order to display the GDOGGS logo and are deliberate fabrications of goods that did not exist in commerce at the time the statement of use was submitted, and do not exist today.” (Dkt. No. 1, at ¶ 32) In response, respondent admitted the salient part of this allegation by stating, “Respondent admits that the products represented by the mock-ups in the Specimen did not exist at the time of the statement of use was filed and do not exist today, but denies the balance of the allegations set forth in Paragraph 32 of the Petition for Cancellation.” (Dkt. No. 7, at ¶ 32)

The record before the Board clearly demonstrates, by respondent’s own admissions that his alleged mark was not being used in commerce at the time of the application or the statement of use, and the goods depicted in the statement of use did not actually exist, and therefore Registration No. 3842092 for the alleged mark GDOGGS must be cancelled.

**B. Respondent did not oppose any substantive arguments in the Motion leaving respondents admissions of record as the only material before the Board for consideration.**

Respondent only opposed the motion for summary judgment on the basis that it was premature and failed to address even a single substantive argument. In the face of

respondent's admissions of non-use, already of record, it is an error for the Board to not view this failure to respond as a concession of the arguments. 37 C.F.R. § 2.127(a) ("... a brief in response to a motion shall be filed within fifteen days from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board.") emphasis added. See also, *Cent. Mfg. v. Surgical Navigation Technologies, Inc.*, 92 F. App'x 789 (Fed. Cir. 2004) (Opponent to trademark application was deemed to have conceded applicant's allegations and arguments by failing to respond to applicant's motion for summary judgment.); *Chesebrough Pond's, Inc. v. Faberge, Inc.*, 618 F.2d 776, 780 (CCPA 1980) (affirming the Board's decision to treat a motion for summary judgment as conceded when the non-moving party failed to file a brief in opposition).

Petitioner's procedural error in failing to make a more formal, separate, initial disclosure, beyond the full attachments to the Petition to Cancel (Dkt. No. 1, Exhibits 1-11) served on respondent has been remedied and should not serve to bar this Board from consideration of the operative admissions of record, and the lack of any substantive argument in opposition. Petitioner's counsel's oversight impacts nothing more than the timing of this Motion, since it can be refilled at any time. And, because each and every one of petitioners disclosures were actually delivered to respondent prior to the filing of the Motion, respondent suffered no prejudice that Trademark Rule 2.127(e)(1) was designed to prevent. In contrast, respondent's failure to respond to the substantive arguments in the Motion, given respondent's admissions of non-use already in the record, is fatal to respondent's registration as a matter of law, and the Motion should be considered conceded.

**C. The unrelated issues and causes of action in the Nevada Litigation between Respondent and Petitioner is not dispositive of this Board proceeding and cannot have any bearing on this Board proceeding.**

The Board correctly recognized that petitioner and respondent (and respondent's attorney) are parties to a civil action in the Eighth Judicial District Court of Clark County, Nevada ("Nevada Litigation"). Trademark Rule 2.117(a) permits suspension of a Board Proceeding when "... parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case."

However, the Nevada Litigation involves the alleged use of "ideas" and "concepts" that do not include the any allegation of use or misuse of respondent's alleged GDOGGS mark or any other trademark theory. On no page of the Complaint in the Nevada Litigation is there any allegation of trade mark misuse, right to use a trademark or any dispute over the ownership of a trademark registration. Absent one of these contested points the Nevada Litigation can have no bearing on the outcome of these Board proceedings.

The primary statement of alleged liability in the Nevada Litigation can be found in Paragraph 44 of the Complaint (Dkt. 1, Exhibit 4, at ¶ 44). The Complaint alleges only design ideas and concepts related to ventilated holes in shoes, the use of a multi-color shoe line, the fact that the shoes may be considered "more fashionable," and the placement and orientation of *petitioner's* DAWGS logos (not respondent's alleged "GDOGGS" mark). None of these allegations are related in any way to respondents alleged GDOGGS mark, or could possibly be determinative of, or have any bearing on, this Board proceeding.

Respondents agree that the Nevada Litigation is unrelated. Paragraph 6, of

respondent's Motion for Extension of Time to Answer states, "Petitioner and Respondent are currently engaged in other litigation unrelated to the Registration..." (Dkt. No. 4, at ¶ 6)

Further the Nevada Litigation contains six causes of action none of which are capable of having any bearing on this Board proceeding. The first two causes of action (Contractual Breach of a Non-Disclosure Agreement and Contractual Breach of the Implied Covenant of Good Faith and Fair Dealing) relate to an alleged contract and contractual damages unrelated to whether or not respondent ever had products in commerce bearing his alleged GDOGGS mark. The third cause of action alleges the Statutory Misappropriation of a Trade Secret. A trademark registration, or a mark on goods, whether or not registered, cannot meet the definition of a Trade Secret under the Uniform Trade Secret Act. The fifth claim for unjust enrichment is an action in equity that has no bearing on the registration of a trademark, or specifically whether respondent ever used the alleged mark GDOGGS in commerce. The sixth claim is for the tort of conversion also cannot have any bearing on whether or not respondent ever had products in commerce bearing his alleged GDOGGS mark.

Only the fourth claim, unfair competition, which is the state law analog to an action under the Lanham Act, could possibly be construed as being a claim involving a trade mark issue, however, even this cause of action could not have any bearing on these cancellation proceedings. No part of the complaint in the Nevada Litigation alleges that USA Dawgs used or misused the alleged GDOGGS mark. No part of the complaint in the Nevada Litigation alleges likelihood of confusion, trademark dilution, passing off, contributory passing off or reverse passing off. Respondent has already admitted that no products existed in commerce bearing the alleged GDOGGS mark (Dkt. No. 7, at ¶ 29), and that "No product bearing the GDOGGS mark was ever produced by petitioner, or by any other party with petitioner's



license or authorization, for use in commerce.” (Dkt. No. 1, at ¶28, admitted Dkt No. 7, at ¶28).

No part of the Nevada Litigation concerns the alleged GDOGGS mark at issue in these cancellation proceedings. Neither petitioner nor respondent has requested a stay of these proceedings. Respondents agree that the two actions are unrelated. No part of the Nevada Litigation is capable of having any determinative effect or any bearing on these Board proceedings. As a result no stay should issue and these proceedings should be permitted to proceed.

#### IV. CONCLUSION

Based on the arguments and reasons above, Petitioner, U.S.A. Dawgs, Inc., respectfully requests that this Board reconsider its decision on petitioner’s Motion for Summary Judgment.

Date: June 21, 2013

Respectfully Submitted,



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of PETITIONER'S REQUEST FOR RECONSIDERATION dated JUNE 24, 2013, has been served on Registrant, James Sanders, by mailing said copy on JUNE 24, 2013, via First Class Mail, postage prepaid, to:

JEFFREY H OLIAN  
LEGALTERNATIVE INC  
1829 N WILMOT  
CHICAGO, CA 60647  
UNITED STATES



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